

## REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

As a preliminary matter, Applicants note the Office Action's acknowledgement of Applicants' election of claims 1-9 for further prosecution and receipt of papers submitted under 35 U.S.C. § 119(a)-(d).

It is noted that in the form SB/08 for the Information Disclosure Statement submitted on July 12, 2005, references A5 and A6 were not initialed. The Examiner is respectfully requested to return another copy of the SB/08 with A5 and A6 initialed.

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,203,044 to Linscott, Jr. in view of U.S. Patent No. 6,329,731 to Arbanas et al. (hereinafter "Arbanas"). Claims 2-9 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

By this amendment, claim 2 has been canceled and independent claim 1 has been amended to further define the subject matter Applicants regard as the invention. Claims 3 and 10 have been amended to update their dependence. New claims 14-22 have been added and claims 4-9 remain unchanged in the application.

This amendment changes, adds, and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. Thus, claims 1 and 3-22 are presently pending in this application for consideration.

Applicants gratefully acknowledge the Office Action's indication that claims 2-9 would be allowable if rewritten in independent form. Applicants at this time intend to pursue patent protection for those objected to claims as described above. The amendment to claim 1 with the allowable subject matter recited in canceled claim 2 is not meant to concede to the appropriateness of the rejection, but instead to merely expedite prosecution of the patent

application. Therefore, Applicants submit that amended independent claim 1, and claims dependent directly or indirectly therefrom, namely claims 3-9 as well as provisionally withdrawn claims 10-13 are allowable.

Regarding new claims 14-22, Applicants respectfully submit that new independent claim 14 is patentably distinguishable over the cited references as required by 35 U.S.C. §§ 102 or 103. Applicants further submit that the cited references, whether considered alone or in combination, fails to disclose Applicants' claimed cooling system for an electric motor arranged such that *a motor case houses an electric motor...wherein an inside of the motor case is separated from an in-shaft refrigerant passage and a refrigerant which passes through the in-shaft refrigerant passage does not enter the motor case*. By contrast, the cited references fail to teach or suggest this claimed arrangement. Accordingly, independent claim 14 and claims dependent therefrom are patentably distinguishable over the cited references. This distinction will be further described below.

#### **NEW CLAIMS 14-22 DISTINGUISH OVER THE CITED REFERENCES**

Although Applicants' claimed invention and Linscott, Jr. relate generally to electric motors, the two address different problems and, not surprisingly, describe different solutions.

Linscott, Jr. is concerned with reducing the time and expense associated with rotor disassembly and replacement (column 1, lines 53 and 54). Linscott, Jr. highlights problems created by varying oil inlet pressures and oil flow requirements of different constant speed drive and auxiliary units for driving AC generators (column 1, lines 43-45). To address this problem Linscott, Jr. discloses a removable hollow tube 62 disposed within a hollow rotor shaft 18 with an outer surface 76 of the hollow tube 62 and an inner surface 50 of the hollow rotor shaft 18 defining a cavity 74 extending axially along the shaft (column 1, lines 57-65 and Fig. 1). The removable hollow tube 62 is provided with holes 78 so that cooling oil provided therein flows into the cavity 74 and out the holes 36, 40, 42 of the hollow rotor shaft 18 for cooling and lubricating portions of the generator 10 (column 1, lines 65-68). The diameter and number of holes in the hollow tube 62 are selected in accordance to the constant speed drives or auxiliary power units having different oil inlet pressures and oil flow

requirements (column 2, lines 2-18). Various portions of the generator 10 are cooled or lubricated including end turns 44 and 46 of field winding structure 20 (column 2, lines 65-68).

Unlike Linscott, Jr., Applicants' claimed invention as defined by new independent claim 14 is not directed to reducing the time and expense associated with rotor disassembly and replacement, but rather is directed to the problem of deteriorating motor parts when a refrigerant is collected in the motor case (page 1, line 25 through page 2, line 2 and page 9, line 25 through page 11, line 1). To address this problem, new independent claim 14 includes the arrangement of *a motor case housing an electric motor...wherein an inside of the motor case is separated from an in-shaft refrigerant passage and a refrigerant which passes through the in-shaft refrigerant passage does not enter the motor case*. Linscott, Jr. fails to disclose this arrangement. As stated above, Linscott, Jr. specifically discloses end turns 44 and 46 of field winding structure 20, which are part of the motor, being cooled or lubricated by the cooling oil. This is at odds with the present invention. Arbanas, cited by the Examiner only for its disclosure of using a reduction unit and the motor being used in a vehicle, does nothing to overcome the shortcomings of Linscott, Jr.

In view of the fact that neither the Linscott, Jr. patent nor Arbanas patent discloses the claimed arrangement indicated above, these references cannot be said to anticipate nor can they be said to render obvious the invention which is the subject matter of independent claim 14. Thus, independent claim 14 is allowable. Since independent claim 14 is allowable, claims 15-22 are also allowable by virtue of their direct or indirect dependence from allowable independent claim 14 and for containing other patentable features.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,


to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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